

REMARKS

Reconsideration of this application as amended is respectfully requested.

Claims 1-34 were pending and rejected. In this response, no claim has been cancelled or amended. No new matter has been added.

Claims 1-34 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2001/0047517 to Christopoulos, et al. (the Christopoulos '517 application) in view of ISO/IEC JTC 1/SC 29/WG 1 N1646 ("JPEG 2000 IMAGE CODING SYSTEM", ISO/IEC JTC 1/SC 29WG 1. JPEG 2000, 16 March 2000, (hereafter referred to as N1646).

Although Applicant had filed a declaration under 37 C.F.R. 1.131 to swear behind the Christopoulos '517 application in a previous response, the Office Action stated that the declaration cannot swear behind the Christopoulos '517 application because the effective filing date of the Christopoulos '517 application is 2/10/2000 which is the filing date of the corresponding provisional application (see, 4/26/2006 Office Action, page 2).

Under 35 U.S.C. 119(e), the written description and drawing(s) (if any) of the provisional application must adequately support and enable the subject matter claimed in the nonprovisional application that claims the benefit of the provisional application.

In *New Railhead Mfg. L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002), the court held that for a nonprovisional application to be afforded the priority date of the provisional application, "the specification of the provisional must 'contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,' 35 U.S.C. 112 ¶1, to enable an ordinary skilled artisan to practice the invention claimed in the nonprovisional application." (Manual of Patent Examining Procedures (MPEP) 201.11).

In this case, the Office Action relied on certain portions of the specification of the Christopoulos '517 application, in combination of N1646, to reject claims 1-34. Specifically, for example, the Office Action cited paragraphs 0035-0041 and Fig. 2 of the Christopoulos '517 application in rejecting claims 1-34 (see, 4/26/2006 Office Action, pages 3-4).

However, it is respectfully submitted that none of the cited sections of the Christopoulos '517 application is disclosed in the corresponding provisional application No. 60/181,565, filed February 10, 2000 (hereinafter the '565 provisional application). For example, at least Figs. 1-5 and their corresponding description of the Christopoulos '517 application are not disclosed in the '565 provisional application. Therefore, it is respectfully submitted that the cited sections of the Christopoulos '517 application are not entitled to the benefit of the '565 provisional application.

Even if, for the sake of the argument, the Office Action insisted that the cited sections of the Christopoulos '517 application were disclosed in the '565 provisional application, the Office Action should rely on the description of the '565 provisional application, rather than the description of the Christopoulos '517 application, in rejecting claims 1-34 of the present application. It is respectfully submitted that the Office Action failed to point out where in the description of the '565 provisional application reads on the limitations of claims 1-34 of the present application. Withdrawal of the rejections is respectfully requested.


In view of the foregoing, Applicant respectfully submits the present application is now in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

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